

60,130-1829 (OOMRA373, 382)

housing and power mechanism in place relative to the one of the window regulator housing and power mechanism."

The problem that applicant was seeking to solve relates to the difficulty of aligning a housing and power mechanism relative to each other on opposite sides of a door panel, such that each component can be attached to the door panel. Traditionally, the housing was aligned on one side of the door panel and, while holding the housing in place, a worker simultaneously held the power mechanism in place relative to the door panel and housing, such that the housing and power mechanism could be assembled onto the door panel. This process is difficult and time consuming.

Applicant's invention provides first and second alignment members that are used to align the housing and power mechanism to the door panel. These alignment members allow the housing and power mechanism components to be assembled onto the door panel without having to simultaneously hold both components.

Such an arrangement of fixing of the window regulator housing 12 relative to the door panel 14 means that the person assembling the various components can initially assemble the window regulator housing 12 relative to the door panel 14 and then subsequently, and without having to hold the window regulator housing 12 in place, can assemble the motor 16 onto the door panel 14. It is clear that a similar arrangement of fixings can be used to secure the door panel 14 and window regulator motor 16." Paragraph [37].

Thus, applicant respectfully asserts that claim 42 is not indefinite and requests that the rejection of claim 42 under 35 U.S.C. 112, second paragraph, be withdrawn.

Claims 21 and 42 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Saito. The examiner argues that Saito discloses a door panel 5 having a first alignment member 5b, 11a formed on one side of the vehicle door panel, and a second alignment member 5c formed on an opposite side of the vehicle door panel. The examiner further argues that Saito discloses a window regulator housing 8 that is aligned relative to the door panel via the first alignment member 5b, 8, and a power mechanism 7 aligned relative to the door panel via the second alignment member 5c. Applicant respectfully disagrees with this interpretation of Saito.

60,130-1829 (00MRA373, 382)

Saito discloses an inner door panel 5 having a recessed portion 5a to accommodate the motor 7. The recessed portion 5a includes three mounting bores 5b at positions that correspond to positions of bolts 11a-11c of the base 8 of the regulator 6. The recessed portion 5a also includes a through hole 5c which is located at a position corresponding to projecting portion 14c of housing 14 of the motor 7. See column 5, lines 17-23.

First, the examiner's first 5b, 11a and second 5c alignment members are not formed on opposite sides of the door panel from each other. Element 11a is a bolt that is part of the base 8 of the regulator 6, and thus is not formed as part of the door panel. Elements "5b" and "5c" of Saito are holes that are cut through the entire thickness of door panel. The holes are not formed on opposite sides from each other.

Further, through hole 5c, which the examiner argues corresponds to the claimed "second alignment member," cannot be used to align the motor relative to the door panel. The hole 5c merely serves as an opening to allow a portion of the motor to extend through the door panel. An elastic member 21 is required to close off the remaining portion of the hole 5c. The hole 5c does not by itself align the motor to the door panel. In Saito, the alignment of the motor 7 and the regulator 6 relative to the panel is accomplished by the bolts 11a-11c, which are not formed as part of the door panel.

Thus, Saito does not disclose, suggest, or teach all of the features set forth in claim 21 and applicant respectfully requests that the rejection be withdrawn. For similar reasons claim 42 is also allowable over Saito.

Claims 24-29 and 41 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Saito in view of Ross. Claim 24 recites the step of forming a single contiguous feature on the vehicle door panel that defines both the first and second alignment members. Saito clearly does not disclose, suggest, or teach this feature. Further, the examiner recognizes that Saito does not disclose this feature as separate, discrete, elements of Saito have been described as corresponding to the claimed first and second alignment members.

Ross also does not disclose, suggest, or teach the features of claim 24. The examiner argues that Ross discloses a means for fastening two components 2, 3 together via panel B in

60,130-1829 (00MRA373, 382)

Figure 2, and that panel B includes a frustoconical projection b. Applicant disagrees with this interpretation of Ross.

Elements 2 and 3 are not components, such as the claimed housing and power mechanism that are attached to a door panel. Elements 2 and 3 are merely spacer washers. Ross discloses a method for attaching metal sheets A and B together in a spaced relationship. Washer 3 is positioned between the sheets A and B to provide the desired spacing. A second washer 2 is positioned on the end of bolt 1 such that a nut 1b can be tightened to secure the sheets A and B together. Ross does not disclose forming a single contiguous feature on a vehicle door panel to form first and second alignment members that are used to align a housing and a power mechanism on opposite sides of the door panel.

Further, there is no motivation or suggestion to modify Saito in the manner argued by the examiner. When it is necessary to select elements from different references in order to form the claimed invention, there must be some suggestion or motivation to make the selection. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. The extent to which such suggestion must be explicit in, or referred from, the references, is decided on the facts of each application in light of the prior art and its relationship to the claimed invention. It is impermissible to engage in a hindsight reconstruction of the claimed invention, using applicant's structure as a template and selecting elements from the references to fill the gaps. The references themselves must provide some teaching whereby applicant's combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

The examiner argues that it would have been obvious to "provide Saito, with a fastening means, as taught by Ross, to prevent shearing or tearing of the door panel." Applicant respectfully disagrees. Claim 24 is directed to the alignment of the housing and the power mechanism relative to the door panel, not to the fastening of the components to the door panel. Ross does not disclose any type of structure that is formed on a door panel that can be used to align two different components relative to opposite sides of the door panel. Instead, Ross is directed to a method for fastening two metal sheets together in a spaced relationship.

60,130-1829 (00MRA373, 382)

Saito sought to provide a mounting structure and a method of mounting that reduced cost and simplified assembly. The inventive method accomplished this by arranging a regulator having a plurality of bolts in a space between inner and outer door panels, and connecting the motor to the bolts of the regulator to fix both the motor and regulator to the inner panel.

The examiner is arguing that the components in Saito should be fastened to the panel with the fastening means taught by Ross. First, as discussed above, Ross discloses attaching two metal sheets A and B to each other in a spaced relationship, and does not disclose attaching two components such as a housing and a power mechanism to opposite sides of a panel. Second, Saito already provides a unique configuration for mounting the regulator and motor to a door panel.

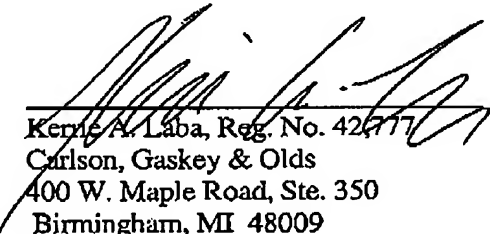
There is nothing in Saito that would have led one of ordinary skill in the art to believe that Saito's mounting configuration was in any way deficient for Saito's purposes or was in need of modification, especially as Saito motor was specifically designed to achieve a beneficial mounting structure within a door panel assembly. The examiner's modification would clearly defeat the benefits achieved by Saito with regard to the mounting configuration. The examiner's proposed modification cannot render the prior art unsatisfactory for its intended purpose and cannot change the principle of operation of the base reference. See MPEP 2143.01. One of ordinary skill in the art would have found no reason, suggestion, or incentive for attempting to combine these references so as to arrive at the subject matter of claim 24 other than through the luxury of hindsight accorded one who first viewed applicant's disclosure.

60,130-1829 (00MRA373, 382)

Thus, for the many reasons set forth above, applicant asserts that the rejection of claims 24-29 and 41 is improper and respectfully requests that the rejection be withdrawn.

Applicant asserts that all claims are in condition for allowance. It is believed that no additional fees are due, however, the Commissioner is authorized to charge Deposit Account No. 50-1482, in the name of Carlson, Gaskey & Olds, for any additional fees or credit the account for any overpayment.

Respectfully submitted,


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CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States patent and Trademark Office, fax number (571) 273-8300, on September 13, 2005.


Kerrie A. Laba